

Appl. No. 10/750,016
Amdt. dated August 2, 2005
Reply to Office Action of May 3, 2005

Remarks

Claims 1-9 and 13-14 are pending in the instant application. Claim 1 has been amended to generally incorporate the elements of claim 2. Claims 3, 7 and 8, which originally depended from claim 2, have been amended to depend from claim 1. Claim 2 has been canceled without prejudice. No new matter has been added by these amendments. Accordingly, Claims 1, 3-9 and 13-14 form the subject matter of this response. Reconsideration of the present application in view of the amendments and the following remarks is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

The combination of VanGompel and Herrin do not teach or suggest each and every element of the claimed invention.

In the Office Action mailed May 3, 2005, the Examiner rejects claims 1 and 13 as being unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,336,922 issued January 8, 2002, to VanGompel et al. (hereinafter "VanGompel") in view of U.S. Patent No. 5,308,345 issued May 3, 1994, to Herrin (hereinafter "Herrin"). This rejection is respectfully **traversed** to the extent that it applies to the presently presented claims. In particular, Claim 1 has been amended to include the elements of claim 2. The Examiner, on page 4 of the Office Action mailed May 3, 2005, recognizes that VanGompel and Herrin fail to disclose each and every element of claim 2. Therefore, claim 1 and claim 13, which depends from claim 1, are believed to be patentable over VanGompel in view of Herrin.

VanGompel, Herrin and Ujimoto, alone or in combination, do not teach or suggest each and every element of the claimed invention.

In the Office Action mailed May 3, 2005, the Examiner rejects claims 2-9 as being unpatentable under 35 U.S.C. §103(a) over VanGompel in view of Herrin and further in view of U.S. Patent No. 4,943,340 issued July 24, 1990 to Ujimoto et al. (hereinafter "Ujimoto"). Claim 1 has been amended to incorporate the limitations of claim 2, and claim 2 has been cancelled. This rejection is **traversed** to the extent that it appliest to the presently presented claims.

Claim 1 of the present invention, as amended, includes, *inter alia*, the steps of "forming a line of weakness in said elastic material web to define a trailing edge of the elastic member;...cutting said elastic material web to define an leading edge of the elastic member; and...separating said elastic material web at said line of weakness into discrete elastic members".

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In order to establish a *Prima Facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

Applicants submit that VanGompel, Herrin and Ujimoto, alone or in combination, do not teach or suggest each and every element of the invention of Claim 1, as amended. That is, VanGompel, Herrin and Ujimoto, alone or in combination, do not teach or suggest the steps of "forming a line of weakness in said elastic material web to define a trailing edge of the elastic member;...cutting said elastic material web to define an leading edge of the elastic member; and...separating said elastic material web at said line of weakness into discrete elastic members".

Applicants note that on page 4 of the Office Action mailed May 3, 2005, the Examiner states that Ujimoto discloses "forming a line of weakness...then cutting said elastic material," referring to Col. 2, lines 1-5 of Ujimoto, and continues stating that Ujimoto discloses "separating said elastic material at said line of weakness," referring to Col. 2, lines 46-51 of Ujimoto. Applicants disagree. A close reading of Col. 2, lines 1-5, and Col. 2, lines 46-51, of Ujimoto reveals that it teaches only cutting an elastic sheet or web. It does not teach forming a line of weakness in the elastic material web, cutting the elastic material web and separating the elastic material at the line of weakness. In fact, the Examiner appears to recognize this at Page 7 of the Office Action mailed May 3, 2005, by stating that "the 'severance axis' disclosed by [Ujimoto] is interpreted by [the] examiner to be the same as applicant's claimed 'line of weakness.'" Nonetheless, the severance axis of Ujimoto is not a "line of weakness" as claimed by the present invention but instead merely discloses the location of where an individual elastic member of Ujimoto is severed. Specifically, Ujimoto, at Col. 2, line 21, describes the severance axis as a location: "severing the continuous web along a severance axis." Moreover, Applicants submit that Ujimoto does not teach or suggest forming a line of weakness in an elastic material web and separating the elastic web at the line of weakness as set forth in claim 1 of the present invention, as amended. Thus, Applicants assert that VanGompel, Herrin and Ujimoto, alone or in combination, fail to teach or suggest all of the elements of claim 1 and the Examiner has therefore not established a *Prima Facie* case of obviousness. For at least these reasons, claim 1 is patentable over the combination of VanGompel, Herrin and Ujimoto. Moreover, claims 3-9, which all eventually depend from claim 1 are likewise patentable over the combination of VanGompel, Herrin and Ujimoto.

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Further, and with respect to claim 8, the Examiner states on Page 5 of the Office Action dated May 3, 2005, that Fig. 2 of VanGompel discloses an elastic member including a trailing edge defining a "w" shape. Fig. 2 of VanGompel illustrates a fit panel 60 that defines a linear trailing edge. Thus, Applicants respectfully request that the Examiner clarify this rejection of claim 8. If such clarification cannot be provided, Applicants request that claim 8 be passed to allowance.

In the Office Action mailed May 3, 2005, the Examiner rejects claim 14 as being unpatentable under 35 U.S.C. §103(a) over VanGompel in view of Herrin and further in view of U.S. Patent No. 5,560,793 issued October 1 to Ruscher et al. (hereinafter "Ruscher"). Claim 14 depends from claim 1. As discussed above, the Examiner has failed to establish a *prima facie* case of obviousness over independent claim 1 in view of VanGompel in combination with Herrin and Ujimoto. Moreover, Ruscher fails to correct for the deficiencies of VanGompel, Herrin and Ujimoto. That is, Ruscher does not teach or suggest the steps of "forming a line of weakness in said elastic material web to define a trailing edge of the elastic member;...cutting said elastic material web to define an leading edge of the elastic member; and...separating said elastic material web at said line of weakness into discrete elastic members".. Therefore, for at these reasons, claim 14 is also patentable over the combination of VanGompel, Herrin, Ujimoto and Ruscher.

Accordingly, for at least the reasons set forth above, Applicants respectfully submit that claims 1, 3-9 and 13-14 are not obvious and are therefore patentable over the cited references whether considered alone or in combination.

In conclusion, and in view of the amendments and remarks set forth above, Applicants respectfully submit that the application and the claims are in condition for allowance and respectfully request favorable consideration and the timely allowance of pending claims 1, 3-9 and 13-14. Further, since Applicants believe Claim 1 to be generic, Applicants request the reintroduction into prosecution and allowance of claims 10 -12. If any additional information is required, the Examiner is invited to contact the undersigned at (920) 721-3862.

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The undersigned may be reached at: 920-721-3862.

Respectfully submitted,

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